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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/666,366

09/19/2003

Fen Huang

34506.143

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25005

7590

09/26/2008

Intellectual Property Dept.

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EXAMINER

HUTSON, RICHARD G

ART UNIT

PAPER NUMBER

1652

MAIL DATE

DELIVERY MODE

09/26/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	Application No. 10/666,366	Applicant(s) HUANG ET AL.	
	Examiner Richard G. Hutson	Art Unit 1652	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 08 September 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
 b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: 1,5,7-10,14-18,22,24-29,31-35,37-40,42-45.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
 12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
 13. ☐ Other: _____.

/Richard G Hutson, Ph.D./
Primary Examiner, Art Unit 1652

Continuation of 11. does NOT place the application in condition for allowance because: Claims 1, 5, 7-10, 14-18, 22, 24-29, 31-35, 37-40 and 42-45 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Mizutani et al. (Microbiol. Immunol., Vol 42 (8), pp 549-553, 1998) and Ambion, Inc. (TechNotes 8(2), SUPERase.In: The Right Choice for Protecting your RNA, web page, www.ambion.com/techlibb/tn/82/823.htm, 10/28/2004, see IDS). Applicants continue to traverse the rejection on the basis that applicants submit that there is no technological reason or motivation to combine the two references in the first instance and therefore the Office has not established a prima facie case of obviousness. Specifically applicants submit that the combination of references fail to provide any evidence or suggestion that "RNases... are known contaminants of RNA preparations."

Applicant's argument is acknowledged and that statement referred to by applicants is acknowledged in the context of the original rejection. "The motivation for the inclusion of SUPERnasin Ribonuclease inhibitor in the methods of RT-PCR taught by Mizutani et al., is that SUPERnasin inhibits RNases that are known contaminants of RNA preparations. Further SUPERnasin works well in RT-PCR reactions and does not need reducing conditions or reducing agents." While this original statement is believed to be accurate, it is believed that applicants have chosen to focus on one aspect of this statement that "RNases... are known contaminants of RNA preparations." Applicants directed dissection of the original motivation statement is questioned, however, it remains that the references as well as the knowledge of the skilled artisan do support such a statement. For instance, Ambion teaches that "RNase inhibitors are typically used during enzymatic reactions to protect RNA from RNase contamination introduced from one or more of several common, but diverse sources". Ambion further teaches that: "RNase inhibitors are typically used during enzymatic reactions to protect RNA from RNase contamination introduced from one or more of several common, but diverse sources, hPRI has been the most widely used ribonuclease inhibitor over the past several decades. RI inhibits RNase A and its carbohydrate variants, RNases B and C. SUPERase-In not only inhibits these RNases, but it also inhibits RNase 1 and RNase T1. When considering where RNase contamination might originate, it becomes clear why you need to inhibit different types of RNases. RNase A, for example, is a common contaminant on laboratory equipment and supplies because it is present on human skin. It is used in large quantities for both plasmid and protein purification, and, along with RNase T1, it is used in ribonuclease protection assays. Bacterial RNases can affect experiments that include bacterial lysates, or proteins or DNA templates that are purified from overexpression in bacteria. Even commercial enzymes can be contaminated with trace amounts of RNases (all types). Environmental sources such as dust, ungloved hands, and contaminated solutions may introduce many different types of RNase."

Thus, it appears that RNases are found throughout the RNA environment and there exists motivation to protect RNA from RNase contamination and the subsequent degradation.

Applicants additionally argue that the combination of the Mizutani et al. and Ambion references fail to suggest all the required elements of the claims. In so arguing it appears that applicants acknowledge that Mizutani et al. heat their mixture to no less than 90°C, but that they do not test for or even suggest to test for any inhibition of RNase activity after activity. Applicants point is acknowledged, however, it is unclear where such a method step of "testing for any inhibition of RNase activity" occurs. Thus applicant's argument on this ground is not found persuasive.

Applicant's complete argument is acknowledged and has been carefully considered, however, is found nonpersuasive for the reasons previously made of record and repeated herein.